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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,632	03/09/2004	Takeshi Tanemura	9281-4775	2795

7590 03/22/2005

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EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT

PAPER NUMBER

2815

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/796,632

Applicant(s)

TAKESHI TANEMURA

Examiner

Jasmine J. Clark

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☒ Claim(s) 3 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/09/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The Information Disclosure Statement filed 03/09/2004 has been fully considered.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (US 5,140,384) in view of Tuttle et al. (US 5,973,263).

Tanaka teaches a device, comprising a substrate on which a wiring pattern is provided; a chip 13 including a wire disposed on a surface of the substrate; a soft resin 27, (for example see Fig. 7) covering the chip and the wire; and a protection member 28 (see abstract) which is made of a relatively hard resin having leg parts extending from upper wall to the substrate, and wherein the leg parts are secured to the substrate. However Tanaka fails to teach including electronic parts. Tuttle teach including electronic elements 30 encapsulated with encapsulation material 40. it would have been obvious to one having ordinary skill in the art at the time the invention was made for Tanaka to include electronic parts as claimed, as is well known in the art.

Art Unit: 2815

Concerning claim 2, wherein the protection member covers the entire exposed surface of the substrate and the entire outer surface of the soft resin, please see Fig. 7, eg.,

Concerning claim 4, please see the above discussion.

### ***Allowable Subject Matter***

3. Claims 3 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applied references fail to teach and/or suggest, wherein the substrate comprises at least one of an inductor formed of a thin film, a resistor formed of a thin film, and/or capacitor formed of a thin film thereon; and the method according to claim 4.

4. The references are cited of interest: Scott et al. (US 5,600,181), Hiramoto (US 2004/0245528 A1), Kadota (US 6,663,943 B2), Takahira et al. (US 5,952,713), Otani et al. (JP 6-45477), and Saito et al. (JP 63-46754) teaches relating to a device including soft resin and hard resin.

### ***Telephone Inquiry Contacts***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. Clark whose telephone number is (571) 272-1726. The examiner can normally be reached on Flex.

Art Unit: 2815

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jjbc/03/20/05

**JASMINE CLARK**  
**PRIMARY EXAMINER**

A handwritten signature in cursive script, appearing to read 'Jasmine Clark', is written below the printed name and title.